



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/824,038

04/14/2004

Kevin Remington Joseph Donovan

15719US01

6038

28710 7590 02/01/2010  
PETER K. TRZYNA, ESQ.  
P O BOX 7131  
CHICAGO, IL 60680

EXAMINER

NAJEE-ULLAH, TARIQ S

ART UNIT

PAPER NUMBER

2453

MAIL DATE

DELIVERY MODE

02/01/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/824,038	<b>Applicant(s)</b> DONOVAN, KEVIN REMINGTON JOSEPH	
	<b>Examiner</b> TARIQ S. NAJEE-ULLAH	<b>Art Unit</b> 2453	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                       |                                                                                         |
|---------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/1/06, 1/9/09</u> | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

This is the second Office action in response to Application 10/824,038 filed on April 14, 2004. Claims 1-78 have been examined and are pending.

#### ***Election/Restrictions***

1. Applicant's election with traverse of group I, claims 1-78, in the reply filed on October 5, 2009 is acknowledged. The traversal is on the ground(s) of the following arguments. Firstly, Applicant argues that "paragraph 3 of the Office Action refers to "all these inventions" but is ambiguous as to which groups or inventions are being referenced" (Applicant's Remarks, mailed October 5, 2009, pg. 2). Examiner acknowledges a typographical error was made in paragraph 3 of the Office Action mailed March 30, 2009 stating "Inventions I, II and III..." instead of Inventions I and II. Examiner apologizes for the typographical mistake. This is not found persuasive because only two groups of claims, claims 1-78 and claims 79-93, were presented in the restriction requirement.

Secondly, Applicant argues that "there is no indication in the Office Action that the examination and searches will not be in more than one class/subclass...the requirement is improper because there is no evidence to support the Examiner's contention of a "serious burden" in the requirement" (Applicant's Remarks, mailed October 5, 2009, pgs 2-3). This is not found persuasive because restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or

Art Unit: 2453

more of the following reasons apply: (a) the inventions have acquired a separate status in the art in view of their different classification.

In the instant case, both inventions were drawn to different class/subclass classifications. Subcombination I has separate utility such as computer to computer protocol implementing and data streaming. Subcombination II has separate utility as computer conferencing. See MPEP § 806.05(d)

The requirement is still deemed proper and is therefore made FINAL.

***Information Disclosure Statement***

2. Information disclosure statements (IDS) submitted by the applicant were received by the Office on March 1, 2006 and January 9, 2009, respectively.
3. Accordingly, the information disclosure statement has been considered by the examiner.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-78 are rejected under 35 U.S.C. 102(e) as being fully anticipated by US Patent No. 6,549,937 to Auerbach et al (Auerbach hereinafter).
6. Claims 1-43 are rejected by Auerbach (col. 13, line 48 - col. 18, line 60).

7. Claims 44-78 rejected as follows:

Regarding claim 44, Auerbach teaches **a system for multi-protocol messaging communication on a computer network, the system comprising: a user interface to permit user entry of data for an outgoing message to be transmitted on the computer network (fig. 3; 116, 126); first and second service providers having first and second communication protocols, respectively (fig. 3, 130, 132); and a message manager in communication with the user interface, the message manager converting data entered through the user interface to the first and second communication protocols for communication over the computer network** (col. 5, lines 26-37; col. 13, line 67 – col. 14, line 2).

Formatted: Indent: First line: 36 pt,  
Line spacing: Double

Regarding claim 45, Auerbach discloses the invention substantially as described in claim 44 above including, **wherein data converted to the first and second communication protocols is transmitted over the computer network using the first and second service providers, respectively** (col. 2, lines 29-32; col. 14, lines 9-17).

Formatted: Normal, Line spacing:  
Double

Regarding claim 46, Auerbach discloses the invention substantially as described in claim 44 above including, **wherein the computer network is the Internet and the first and second service providers are instant messaging service providers, the outgoing message being an instant message transmitted from the user interface to first and second message recipients who are subscribers to the first and second service providers, respectively, the message manager converting the instant message to the first and second communication protocols for instant**

Formatted: Indent: First line: 36 pt,  
Line spacing: Double

Art Unit: 2453

**messaging and transmitting the instant message to the first and second service providers, respectively** (col. 2, lines 29-32; col. 14, lines 9-17).

Regarding claim 47, Auerbach discloses the invention substantially as described in claim 44 above including, **wherein the outgoing message is a command from the user interface to the first and second service providers** (col. 2, lines 35-37; col. 14, lines 24-26).

Regarding claim 48, Auerbach discloses the invention substantially as described in claim 44 above including, **wherein the outgoing message is a status inquiry from the user interface to the first and second service providers, to obtain status data for first and second individuals coupled to the computer network via the first and second service providers, respectively** (col. 14, lines 27-31).

Regarding claim 49, Auerbach discloses the invention substantially as described in claim 44 above including, **wherein the first and second service providers have first and second sets of operational capabilities, respectively, and the outgoing message is a command to request capabilities data related to the first and second sets of operational capabilities** (col. 14, lines 32-36).

Regarding claim 50, Auerbach discloses the invention substantially as described in claim 44 above including, **wherein an incoming message is received via the computer network from a selected one of the first and second service providers, the message manager being further operable to convert the incoming message**

Art Unit: 2453

**received from the selected one of the first and second service providers** (col. 14, lines 18-24).

Regarding claim 51, Auerbach discloses the invention substantially as described in claim 50 above including, **further comprising a display wherein the user interface receives data related to the incoming message from the message manager and displays the incoming message on the display** (col. 14, lines 62-65).

Regarding claim 52, Auerbach discloses the invention substantially as described in claim 44 above including, **further comprising a storage area to maintain a contact list containing identification data for a plurality of individuals and data related to their respective service providers** (col. 14, line 66 – col. 15, line 2).

Regarding claim 53, Auerbach discloses the invention substantially as described in claim 52 above including, **wherein the outgoing message is designated for transmission to a first recipient coupled to the computer network via the first service provider, the message manager using data related to service providers to convert the outgoing message to the first communication protocol and transmitting the outgoing message using the first communication protocol to the first designated recipient** (col. 15, lines 3-10).

Regarding claim 54, Auerbach discloses the invention substantially as described in claim 44 above including, **further comprising first and second provider storage areas associated with the first and second service providers, respectively, to maintain first and second provider contact lists containing identification data for**

Art Unit: 2453

**individuals that are subscribers to the first and second service providers, respectively** (col. 15, lines 17-22).

Regarding claim 55, Auerbach discloses the invention substantially as described in claim 54 above including, **further comprising a first server associated with the first service provider, the first provider storage area being maintained in association with the first server** (col. 15, lines 22-26).

Regarding claim 56, Auerbach discloses the invention substantially as described in claim 54 above including, **wherein the user interface is executed on a local computer platform and the first provider storage area is maintained on the local computer platform** (col. 15, lines 27-30).

Regarding claim 57, Auerbach discloses the invention substantially as described in claim 54 above including, **further comprising a combined contact list storage area to store both the first and second provider contact lists as a combined contact list** (col. 15, lines 31-33).

Regarding claim 58, Auerbach discloses, **a system for multi-protocol messaging communication on a computer network, the system comprising: a user interface to permit user entry of data for an outgoing message to be transmitted on the computer network (fig. 3; 116, 126); first and second service providers having first and second communication protocols, respectively (fig. 3, 130, 132); and a message manager in communication with the user interface, the message manager converting data entered through the user interface to at least**



Art Unit: 2453

**one of the first and second communication protocols for communication over the computer network** (col. 5, lines 26-37; col. 13, line 67 – col. 14, line 2).

Regarding claim 59, Auerbach discloses **a system for multi-protocol messaging communication on a computer network, the system comprising: a user interface to permit user entry of data for an outgoing message to be transmitted on the computer network** (fig. 3; 116, 126); **first and second service providers having first and second communication protocols, respectively** (fig. 3, 130, 132); **a database containing the first and second communication protocols; and a message manager in communication with the user interface and the database, the message manager retrieving at least one of the first and second communication protocols and converting data entered through the user interface to at least one of the first and second communication protocols for communication over the computer network** (col. 5, lines 26-37; col. 13, line 67 – col. 14, line 2).

Regarding claim 60, Auerbach discloses **a computer-readable medium containing computer-executable instructions for performing a method of multi-protocol messaging communication on a computer network, the method comprising: sensing user entry of data for an outgoing message to be transmitted on the computer network** (col. 15, lines 37-38); **establishing a communication link with first and second service providers having first and second communication protocols, respectively** (col. 15, lines 41-43); and **converting data entered by a user to at least one of the first and second**

Art Unit: 2453

**communication protocols for communication over the computer network** (col. 15, lines 49-52).

Regarding claim 61, Auerbach discloses the invention substantially as described in claim 60 above including, **further comprising transmitting data converted to the at least one of the first and second communication protocols over the computer network using a corresponding one of the first and second service providers** (col. 15, lines 53-56).

Regarding claim 62, Auerbach discloses the invention substantially as described in claim 60 above including, **wherein the computer network is the Internet and the first and second service providers are instant messaging service providers, the outgoing message being an instant message transmitted from the user interface to at least one of first and second message recipients who are subscribers to the first and second service providers, respectively, by converting the instant message to the at least one of the first and second communication protocols for instant messaging and transmitting the instant message to at least one of the first and second service providers** (col. 15, lines 57-67).

Regarding claim 63, Auerbach discloses the invention substantially as described in claim 60 above including, **further comprising computer-executable instructions for routing the outgoing message to at least one of the first and second service providers, respectively, and for converting the outgoing message within the at**

**least one of the first and second service providers to the at least one of the first and second communication protocols** (col. 16, lines 1-9).

Regarding claim 64, Auerbach discloses the invention substantially as described in claim 60 above including, **wherein the outgoing message is a command from the user interface to the first and second service providers** (col. 16, lines 9-12 ).

Regarding claim 65, Auerbach discloses the invention substantially as described in claim 60 above including, **wherein the first and second service providers have first and second sets of operational capabilities, respectively, and the outgoing message is a command to request capabilities data related to the first and second sets of operational capabilities** (col. 16, lines 12-16).

Regarding claim 66, Auerbach discloses the invention substantially as described in claim 65 above including, **further comprising computer-executable instructions for routing a subsequent outgoing message to at least one of the first and second service providers based on the capabilities data wherein the capabilities data indicates an operational capability to process the subsequent outgoing message and wherein the subsequent outgoing message is not routed to ones of the first and second service providers for which the capabilities data indicates no operational capability to process the subsequent outgoing message** (col. 16, lines 17-30).

Regarding claim 67, Auerbach discloses the invention substantially as described in claim 60 above including, **further comprising computer-executable instructions**

Art Unit: 2453

**for processing an incoming message received via the computer network from a selected one of the first and second service providers, the application program interface further defining a set of data structures to support data transfer, including the incoming message, from the selected one of the first and second service providers to the user interface, and converting the incoming message received from the selected one of the first and second service providers (col. 16, lines 31-41).**

Regarding claim 68, Auerbach discloses the invention substantially as described in claim 67 above including, **further comprising computer-executable instructions for receiving data related to the incoming message and displaying the incoming message on the display** (col. 16, lines 42-46).

Regarding claim 69, Auerbach discloses the invention substantially as described in claim 60 above including, **further comprising computer-executable instructions for maintaining a contact list containing identification data for a plurality of individuals and data related to their respective service providers** (col. 16, lines 47-51).

Regarding claim 70, Auerbach discloses the invention substantially as described in claim 69 above including, **wherein the outgoing message is designated for transmission to a first recipient coupled to the computer network via the first service provider, the computer-readable medium further comprising computer-executable instructions for using the data related to service providers to convert**

**the outgoing message to the first communication protocol and transmitting the outgoing message using the first communication protocol to the first designated recipient** (col. 16, lines 52-60).

Regarding claim 71, Auerbach discloses the invention substantially as described in claim 70 above including, **further comprising computer-executable instructions for using the data related to service providers to convert the outgoing message to the first service provider for conversion to the first communication protocol** (col. 16, lines 61-65).

Regarding claim 72, Auerbach discloses the invention substantially as described in claim 60 above including, **72. The computer-readable medium of claim 60 wherein the first and second service providers include first and second provider storage areas associated with the first and second service providers, respectively, to maintain first and second provider contact lists containing identification data for individuals that are subscribers to the first and second service providers, respectively, the computer-readable medium further comprising computer-executable instructions for retrieving the identification data from the first and second provider contact lists** (col. 16, line 66 – col. 17, line 9).

Regarding claim 73, Auerbach discloses the invention substantially as described in claim 72 above including, **wherein the first service provider includes a first server associated therewith, with the first provider storage area being maintained in association with the first server, the computer-readable medium further**

**comprising computer-executable instructions for retrieving the first provider contact list from the first server** (col. 17, lines 10-16).

Regarding claim 74, Auerbach discloses the invention substantially as described in claim 72 above including, **wherein the instructions are executed on a local computer platform and the first provider storage area is maintained on the local computer platform, the computer-readable medium further comprising computer-executable instructions for retrieving the first provider contact list from the local computer platform** (col. 17, lines 17-23).

Regarding claim 75, Auerbach discloses the invention substantially as described in claim 72 above including, **further comprising computer-executable instructions for combining the first and second provider contact lists as a combined contact list and storing the combined contact list** (col. 17, lines 24-27).

Regarding claim 76, Auerbach discloses **a method for multi-protocol messaging communication on a computer network, the method comprising: sensing user entry of data for an outgoing message to be transmitted on the computer network** (col. 17, lines 30-31); **establishing a communication link with first and second service providers having first and second communication protocols, respectively** (col. 17, lines 34-37); **and converting data entered by a user to the first and second communication protocols for communication over the computer network** (col. 17, lines 42-44).

Art Unit: 2453

Regarding claim 77, Auerbach discloses the invention substantially as described in claim 76 above including, **further comprising transmitting data converted to the first and second communication protocols over the computer network by way of the first and second service providers, respectively** (col. 17, lines 45-47).

Regarding claim 78, Auerbach discloses the invention substantially as described in claim 76 above including, **wherein the outgoing message is an instant message** (col. 14, lines 11-12).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US 6,564,261 to Gudjonsson et al; US 6,301,609 to Aravamudan et al; US 6,606,647 to Shah et al; US 6,490,274 to Kim; US 6,750,881 to Appelman; US 6,212,548 to DeSimone et al; US 7,143,356 to Shafrir et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TARIQ S. NAJEE-ULLAH whose telephone number is (571)270-5013. The examiner can normally be reached on Monday through Thursday 8:00 - 6:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2453

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. S. N./  
Examiner, Art Unit 2453  
January 15, 2010

/Joseph Thomas/  
Supervisory Patent Examiner, Art Unit 2453